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KRIEG DEVAULT LLP ONE INDIANA SQUARE SUITE 2800 INDIANAPOLIS, IN 46204-2079			EXAMINER PIERCE, WILLIAM M	
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/617,993  
Filing Date: July 11, 2003  
Appellant(s): TOTH, ROBERT

**MAILED  
JUL 17 2007  
GROUP 3700**

\_\_\_\_\_  
Clifford Browning  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 2/13/2006 appealing from the Office action mailed 11/02/2005.

This case is related to co-pending application 11/448,394

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In line with the *Interim Guidelines* and MPEP 2106, it is the claimed invention as a whole that must be useful and accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." *State Street*, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (*Brenner v. Manson*, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96 (1966)); *In re Fisher*, 421 F.3d 1365, 76 USPQ2d 1225 (Fed. Cir. 2005); *In re Ziegler*, 992 F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)). In other words, one skilled in the art can use a claimed discovery in a manner which provides some immediate benefit to the public. Here there is no immediate benefit of record to the public that is brought about by the steps of the claimed method. In evaluating what is accomplished by the claimed invention, one can see that the game of bowling itself and the bowlers remain the same and are not changed. For example, better bowlers are not a result nor is there any other advantage of record to the bowling industry such as more money being able to be made by the bowling centers.

One type of subject matter the courts have found to be outside the four statutory categories of invention is abstract ideas. See, e.g., *Rubber-Tip Pencil Co. v. Howard*, 87 U.S. (20 Wall.) 498, 507 (1874) ("idea of itself is not patentable, but a new device by

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which it may be made practically useful is”); Mackay Radio & Telegraph Co.v. Radio Corp. of America, 306 U.S. 86, 94, 40 USPQ 199, 202 (1939). To satisfy section 101 requirements, a claimed process must be for a practical application, which can be identified in various ways. First, the claimed invention “transforms” an article or physical object to a different state or thing and second the claimed invention otherwise produces a useful, concrete and tangible result. Here, the claims are directed to an abstract idea whose steps fail to provide any transformation or produce concrete and tangible results. The courts are concerned that one may not patent every “substantial practical application” of an idea because such a patent “in practical effect be a patent on the idea itself.” Gottschalk v. Benson, 409 U.S. 63, 71-72, 175 USPQ 673, 676 (1972).

In evaluating the pending claims, one can see no concrete result. By definition something which is concrete is “having a material, perceptible existence; of, belonging to, or characterized by things or events that can be perceived by the senses; real; actual.” Here the “eight champions” are not considered concrete. One test for concreteness of a claimed process would be evident where the results can be substantially repeatable or produce the same result again. In re Swartz, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000). We can see that this is not the case with the instant claims. Taking the same pool of players from step a. of claim 1 and practicing steps b-e would not likely result in the same “eight champions” each time the method is practiced. Hence, since the method could not produce the same results again, it fails to meet this test for concreteness as being unrepeatable. Another test is

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that the results must be predictable. Here the results are considered unpredictable because different players on different days can either win or loose the tournament.

Likewise, the final result of the claimed process is intangible. Something which is tangible, by its ordinary meaning, is "that which can be touched...having actual form and substance". Can one actually touch "eight champions"? Obviously not, since such is merely a designation or title given to a player of the original pool of eligible players. Further evidence of non-tangible results of the claimed invention can be seen in that there is no physical transformation. In other words the treatment of the materials (i.e. the pool of eligible players) is not reduced to a different state or thing. Neither are there any "given results" achieved by the method nor is the subject matter changed to a something different than existed before the steps were performed. The pool of players that starts the steps of the claimed method exists the same after they perform them and they are not any different by appearance, skill or product made. These players are not transformed to a different state or thing as required, but exist in the same state and the same at every level as they did before practicing the steps of the claimed method. The eight champions from the pool of players are merely given a designation or title for accomplishing predetermined tasks. These champions are not different in anyway after performing the steps to the claimed invention other than their designation as a champion bestowed upon them. Further, this requirement for a "transformation" is supported by the non-statutory nature of a manipulation of abstract ideas when the interpretation of the claims is that they do not expressly or implicitly require performance of any of the steps by a machine (or physical apparatus). Clearly there is no machine

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being claimed, but merely a manipulation of people. As such, the Board should sustain this grounds for rejection in finding the claims are drawn to non-statutory subject matter.

In summary, since the claimed process clearly recites a judicial exception (abstract idea) and since the judicial exception is not practically applied in the form of a physical transformation or useful, concrete and tangible result, the claimed invention is not eligible for patent protection.

Not discussed in the *Guidelines* is that claim 1 generally relates to a manipulation of "people" (or player i.e. league of players). In line with MPEP 2105,

"If the broadest reasonable interpretation of the claimed invention as a whole encompasses a human being, then a rejection under 35 U.S.C. 101 must be made indicating that the claimed invention is directed to nonstatutory subject matter."

This position is not the same as the "human step test" applied when steps are carried out by a human as discussed in Annex III of the *Guidelines* as an improper test for subject matter eligibility. Here appellant is not merely reciting steps carried out by a human, but is actually claiming humans in his pool eligible league players of step a. of claim 1 and 8 tournament champions of step e. *The Board should recognize the constitutional prohibition against any party owning property right in a human being.* As in the instant claims, is appellant claiming a property right to a pool of eligible players and tournament champions? Most broadly, this is the case here. Certainly appellant is not entitled by statute to own any rights in persons contained in a pool of eligible players or eight champions and the grounds for rejection should be sustained on this basis.

**(10) Response to Argument**

The Board is asked to be aware that the 101 rejection was first made in this application on 2/10/2005 before the Interim *Guidelines* were in place and before the revisions of MPEP 2106. While the initial prosecution history had many provisions of the old MPEP, this rejection under 101 as it is now placed before the Board was brought into strict conformance with both the *Guidelines* and current MPEP 2106.

Pgs. 4 through the top of pg. 7 of Appellant's remarks amount to an interpretation of the *Guidelines* and Annex I contained therein. No further comment is deemed necessary.

At the top of pg. 7, appellant submits the single argument in a conclusion that his invention "achieves a final result, namely, eight tournament champions prevailing..." (In. 4). Appellant offers no evidence or further argument to support his conclusion. As set forth in the grounds for rejection above, it is the position of the Office that these results are not "useful, concrete and tangible" and supports this conclusion in accordance with the *Guidelines*. Further, applicant has no right to be claiming human beings in the form of eight tournament champions. Here appellant has surely not met his burden of showing why his invention is eligible for patent protection. The mere conclusion that he finds his final results of eight tournament champions to be concrete and tangible without any further support falls way short of meeting his burden to overcome the grounds for rejection. (After the examiner identifies and explains in the record the basis for why a claim is for an abstract idea with no practical application, then the burden shifts to the applicant to either amend the claim or make a showing of why the claim is eligible for



patent protection. See, e.g., *In re Brana*, 51 F.3d 1560, 1566, 34 USPQ2d 1436, 1441 (Fed. Cir. 1995); see generally MPEP § 2107 (Utility Guidelines)). Based on this, the Board is asked to sustain the grounds for rejection.

Where applicant argues that the examiner's position was not "processed under the Guidelines" (ln. 8). First, this argument is not to be persuasive to the Board since such an issue is appealable. The *Guidelines* themselves clearly set forth that; "These Guidelines do not constitute substantive rulemaking and hence do not have the force and effect of law. These Guidelines have been designed to assist USPTO personnel in analyzing claimed subject matter for compliance with substantive law. Rejections will be based upon the substantive law and it is these rejections which are appealable. Consequently, any failure by USPTO personnel to follow the Guidelines is neither appealable nor petitionable." Further, contrary to appellants remarks, the examiner's position and process by which his determinations were made have been processed using the *Guidelines* as set forth in the grounds for rejection above. While at the top of pg. 5, applicant states that "the examiner must follow four steps". The Guidelines do not place any requirement on form and/or detail in which the examiner must communicate his findings and conclusions. As such, this argument is found unpersuasive and the grounds for rejection should be affirmed.

Lastly, appellant fails to argue the examiner's position that claims 1-6 generally relates to a manipulation of "people" (or player i.e. league of players). In line with MPEP 2105. As such the grounds for rejection should be sustained.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/William Pierce/

Primary Examiner 3711

Conferees:

Tom Hughes

Gene Kim

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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Gene Kim /Gene Kim/